Request for extension of time under 37 C.F.R. §1.136

Assignee herewith petitions the Director of the United States Patent and Trademark Office to extend the time for response to the Office Action dated November 19, 2002 for 3 month(s) from February 19, 2003 to May 19, 2003.

Please charge Deposit Account #02-2666 in the amount of:

_____	($110.00 for a one month extension)
_____	($400.00 for a two month extension)
__X___	($930.00 for a three month extension)
_____	($1,440.00 for a four month extension)

to cover the cost of the extension.

Remarks

Reexamination and reconsideration of this application, is requested. Claims 1-22 remain in the. No new claims have been added or canceled.

Applicant believes there is no additional charge for this response because no new claims have been added.

Response to the 35 U.S.C. §102(e) Rejection

The Final Office Action rejects claims 1-22 under 35 U.S.C. §102(e) as being anticipated by Tischler et al. (US 2001/0049771 A1). Applicant respectfully traverses this rejection in view of the remarks that follow.

As is well-established, in order to successfully assert a *prima facie* case of anticipation, the Final Office Action must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Therefore, if even one element or limitation is missing from the cited document, the Office Action has not succeeded in making a prima facie case.

Applicant begins with claim 1, which recites, among other things, **prioritizing** a locked way of the cache higher than a recently used way. Applicant respectfully submits that Tischler et al. cannot anticipate Applicant's claims because, at a minimum,

Tischler et al. does not teach or suggest locking a way, and/or then prioritizing the locked way higher than a recently used way as explained for the reasons below.

Tischler et al. contains no express teaching or suggestion of prioritizing

To begin, the portion of Tischler et al. relied upon by the Examiner contains no express teaching of prioritizing locked ways higher than other ways. The text of Tischler doesn't even mention the terms "prioritize", "prioritizing" or any derivative thereof.

Although the scope of Applicant's invention is not limited in this respect, Applicant's specification states "In this particular embodiment, the highest priority is given to a way (e.g., one of ways 31-34) that is locked, although the scope of the present invention is not limited in this respect. For example, a way that is locked is given higher priority over the most recently accessed way. Thus, LRU update controller 90 may indicate that a locked way is the highest priority (e.g., most recently used) even though it has not been accessed by processor 110 during one of the recent requests for information." (page 11, line 21, to page 12, line 2). **As is clear from this example, prioritization relates to the ordering of the ways and is not specifically limited to just locking a way to prevent it from being victimized as suggested by the Examiner during the interview.**

Applicant respectfully points out that the relied upon portion of Tischler et al. does not contain any discussion of prioritizing, ranking, etc. of ways. Therefore, Tischler et al cannot anticipate Applicant's claim 1 because Tischler et al. is devoid of the prerequisite teaching to establish a prima facie showing.

The Final Office action has not made the perquisite showing to rely on inherency

As demonstrated above, Tichschler et al. does not contain any express teaching or suggestion of prioritizing a lock way higher than a way to be victimized in accordance with Applicant's claim 1. The Final Office Action has conceded at least this point as the Final Office action is relying on inherency to demonstrate that this feature is taught or suggested by Tischler et al.

In particular, the Final Office stated on page 5, paragraph 5, that "... one **should** realize realize [sic] that the way being locked (way 1) **should** have higher priority that [sic] the non-locking ways." In other words, the Final Office Action suggests that one skilled in the art may interpret the reference to teach prioritizing in accordance with Applicant's claim 1 even though Tischler et al. does not expressly teach this feature.

However, the Court of Appeals for the Federal Circuit has stated repeatedly, that Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *948 F.2d at 1269, 20 USPQ2d at 1749* (quoting I *n re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981))."* Thus, in order to establish a prima facie showing, the Final Office Action must establish that Tischler et al. must teach prioritizing.

Applicant respectfully submits that, at a minimum, the rejection is improper because the Final Office Action has not demonstrated that the teaching or suggestion of prioritization must necessarily result. As explained above, and conceded by the Final Office Action, Tischler et al. does not contain any express teaching or suggestion of prioritizing or ranking. Since Tischler et al. does not teach this feature, Applicants respectfully submit that Tischler et al. cannot inherently disclose this feature. Thus, the Final Office Action's reliance upon inherency must be improper.

Applicant would also like to point out that a discussion of prioritizing ways is only found in Applicant's specification, not Tischler et al. However, as is well established, it is improper to rely on Applicant's specification as a basis for inherency.

Tischler et al. cannot inherently teach prioritization as this contrary to the express teaching of Tischler et al.

The CAFC has also establish that a feature cannot be inherent if the feature is not consistent with the express teachings of the relied upon document. For example, the Court of Appeals for the Federal Circuit recently reversed an Examiner's rejection that was based in part on inherency. See, In re Frank S. Glaug, 2002 U.S. App Lexis 4246 (Fed Cir. 2002).

In the present case, Applicant would like to point out that Tischler et al. teach in paragraph 62 that a locked way **is not prioritized higher than the other ways of the cache.** Tischler et al. teach that a "least recently used" LRU indicator is used to determine which of the ways in the cache is the least recently used. Tischler et al. further teach that the LRU algorithm may even identify that a locked way is the least recently used way – "Locking down a Way means that the Way is never replaced **regardless** of the "least recently used" use indicator" (emphasis added.)

However, Tischler et al. teach that because the way is locked, it is not victimized even though the locked way was identified by the LRU algorithm as being the least recently used way. **In other words, Tischler et al. teaches that a locked way is not prioritized higher than the other ways when the LRU indicator is used, instead a locked way is considered by the LRU algorithm.** The LRU algorithm cannot prioritize the locked way as part of the analysis. Thus, Tischler et al. teach away from Applicant's claimed invention.

Since Tischler et al. teaches away from a feature of Applicant's claim 1, it cannot inherently teach prioritization as suggested by the Final Ofice Action.

Thus, Applicant respectfully submits that Tischler et al. cannot anticipate Applicant's claims 1-22 for at least these reasons.

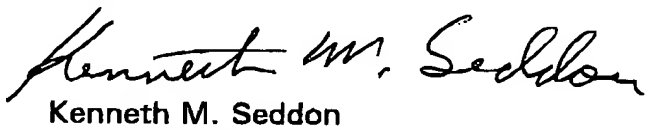
Conclusion

The foregoing is submitted as a full and complete response to the Final Office Action mailed November 18, 2002, and it is submitted that claims 1-22 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims 1-22 is earnestly solicited.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,
Robert D. Bateman



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